

P1 1092331

REC'D 21 NOV 2003

WIPO

PCT

# THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

November 13, 2003

THIS IS TO CERTIFY THAT ANNEXED HERETO IS A TRUE COPY FROM THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE OF THOSE PAPERS OF THE BELOW IDENTIFIED PATENT APPLICATION THAT MET THE REQUIREMENTS TO BE GRANTED A FILING DATE.

APPLICATION NUMBER: 60/415,609

FILING DATE: October 01, 2002

RELATED PCT APPLICATION NUMBER: PCT/US03/31151

By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS



*M. Sias*

M. SIAS  
Certifying Officer

**PRIORITY DOCUMENT**  
SUBMITTED OR TRANSMITTED IN  
COMPLIANCE WITH  
RULE 17.1(a) OR (b)

10-03

502

A/PRO

Please type a plus sign (+) inside this box

+

Approved for use through 10/31/2002. OMB 0651-0032  
 U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# PROVISIONAL APPLICATION FOR PATENT COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(c).

INVENTOR(S)					
Given Name (first and middle (if any))		Family Name or Surname		Residence (City and either State or Foreign Country)	
Ernest R. Aaron M.		FERNANDEZ MARKOVITZ		1379 Danby Avenue, San Jose, CA 95132 888 Logan Street, Apt. 11A, Denver, CO 80203	
<input type="checkbox"/> Additional inventors are being named on the _____ separately numbered sheets attached hereto					
TITLE OF THE INVENTION (280 characters max)					
PRESCRIPTION ADAPTER RING AND EYEWEAR INCORPORATING SAME					
Direct all correspondence to: CORRESPONDENCE ADDRESS					
<input type="checkbox"/> Customer Number		<input type="text"/>		<div style="border: 1px solid black; padding: 5px;">Place Customer Number Bar Code Label here</div>	
OR Type Customer Number here					
<input checked="" type="checkbox"/> Firm or Individual Name		Steven B. Pokotilow			
Address		STROOCK & STROOCK & LAVAN LLP			
Address		180 Maiden Lane			
City		New York		State	NY
Country		US		ZIP	10038
		Telephone		(212) 806-5400	Fax (212) 806-6006
ENCLOSED APPLICATION PARTS (check all that apply)					
<input checked="" type="checkbox"/> Specification Number of Pages		7		<input type="checkbox"/> CD(s), Number	
<input checked="" type="checkbox"/> Drawing(s) Number of Sheets		6		<input checked="" type="checkbox"/> Other (specify)	
<input type="checkbox"/> Application Data Sheet. See 37 CFR 1.76					
METHOD OF PAYMENT OF FILING FEES FOR THIS PROVISIONAL APPLICATION FOR PATENT (check one)					
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.		A check or money order is enclosed to cover the filing fees		FILING FEE AMOUNT (\$)	
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge filing fees or credit any overpayment to Deposit Account Number		19-4709		\$80.00	
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.					
The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.					
<input checked="" type="checkbox"/> No					
<input type="checkbox"/> Yes, the name of the U.S. Government agency and the Government contract number are: _____					

Respectfully submitted,

SIGNATURE

TYPED or PRINTED NAME

TELEPHONE

Steven B. Pokotilow, Esq.

(212) 806-5400

Date

10/1/02

REGISTRATION NO.

(if appropriate)

Docket Number:

26,405

461391/0002

## USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT

This collection of information is required by 37 CFR 1.51. The information is used by the public to file (and by the PTO to process) a provisional application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the complete provisional application to the PTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Box Provisional Application, Assistant Commissioner for Patents, Washington, D.C.

P18SMALL/REV05

Docket No.  
461391/0002  
SBP/CEC

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Ernest R. Fernandez et al.

Art Unit: To be Assigned

Application No.: New Application

Examiner: To be Assigned

Filed: Concurrently Herewith

For: **PRESCRIPTION ADAPTER RING AND EYEWEAR  
INCORPORATING SAME**

Date: October 1, 2002

Box Provisional Patent Application  
Commissioner for Patents  
Washington, DC 20231

**CERTIFICATE OF MAILING**  
**BY "EXPRESS MAIL" (37 C.F.R. § 1.10)**

Sir:

I hereby certify that the following correspondence **Provisional Application for Patent Cover Sheet (Small Entity) in duplicate (1 p.); Specification (7 pp. plus cover sheet); Drawings (6 sheets, Figs. 1-10); Unexecuted Declaration (3 pp.) and return postcard.**

is being deposited on October 1, 2002 with the United States Postal Service for "Express Mail Post Office to Addressee" delivery under 37 C.F.R. § 1.10 in an envelope bearing sufficient postage and addressed to: **Commissioner for Patents, Washington, DC 20231, Box Provisional Patent Application.**

**Beatrice Cahn**

(Typed Or Printed Name Of Person Mailing Correspondence)

*Beatrice Cahn*

(Signature Of Person Mailing Correspondence)

**EL 826845823 US**

("Express Mail" Mailing Label Number)

APPLICATION OF

**ERNEST R. FERNANDEZ**

**and**

**AARON M. MARKOVITZ**

**FOR LETTERS PATENT OF THE UNITED STATES**

**PRESCRIPTION ADAPTER RING  
AND EYEWEAR INCORPORATING SAME**

Steven B. Pokotilow  
Registration No. 26,405  
Attorney for Applicants  
STROOCK & STROOCK & LAVAN LLP  
180 Maiden Lane  
New York, New York 10038  
(212) 806-5400

Atty. Docket No.: 461391/0002

**TITLE**  
**PRESCRIPTION ADAPTER RING  
AND EYEWEAR INCORPORATING SAME**

**FIELD OF THE INVENTION**

[001] The present invention relates to prescription eyewear, and in particular, relates to a prescription lens adapter ring for use with wrap-type eyewear.

**BACKGROUND OF THE INVENTION**

[002] Standard wrap-type eyewear is designed to fit closely to the face. The actual lens used in the typical wrap-type eyewear must also be "wrapped", i.e., have a relatively large curvature. This works fine for normal, non-prescription type lenses. This also generally works fine for prescription lenses in the plus or minus three power range. However, because of the optics involved, it is generally not possible to make a prescription lens having a large curvature for prescriptions in a higher power range. Thus, no one has been able to offer a prescription lens in wrap-type eyewear for prescriptions in a generally higher power range. The present invention is directed towards overcoming disadvantages of the prior art by providing a prescription adapter ring for use with higher power prescription lens.

**SUMMARY OF THE INVENTION**

[003] The present invention relates to a prescription adapter ring for use in eyewear, and in particular, a prescription adapter ring for use in wrap-type eyewear. The adapter ring is designed to fit into the channel or groove where a typical lens is normally installed. The inner surface of the adapter ring has a groove or channel to accept a prescription lens therein. Thus, the prescription adapter ring permits Panoptx, Inc., the assignee of the present

invention, to offer a high wrap prescription sunglass product. Because the ring is constructed so as to fit in the groove normally housing a lens, the prescription adapter ring of the present invention can also be used to retrofit existing eyewear.

[004] Other objects and features of the present invention will become apparent from the following detailed description, considered in conjunction with the accompanying drawing figures. It is to be understood, however, that the drawings are designed solely for the purpose of illustration and not as a definition of the limits of the invention, for which reference should be made to the appended claims.

#### **BRIEF DESCRIPTION OF THE DRAWINGS**

[005] In the drawing figures, which are not to scale, and which are merely illustrative, and wherein like reference characters denote similar elements throughout the several views:

[006] FIG. 1 is a perspective view of eyewear having two removable prescription adapter rings mounted thereon;

[007] FIG. 2 is an exploded perspective view of the eyewear of FIG. 1 with one of the prescription adapter rings separated from the eyewear;

[008] FIG. 3 is a top partial cross sectional view of the eyewear of FIG. 1;

[009] FIG. 4 is a cross sectional view taken along the 4-4 line depicted in FIG. 1;

[0010] FIG. 5 is an enlarged view of the circled area depicted in FIG. 3;

[0011] FIG. 6 is a perspective view of eyewear having two removable prescription adapter rings mounted thereon, with the eyewear also having a removable eyecup installed on the rear side thereof;

[0012] FIG. 7 is an exploded perspective view of the eyewear of FIG. 6 with one of the prescription adapter rings separated from the eyewear;

- [0013] FIG. 8 is a top partial cross sectional view of the eyewear of FIG. 6;
- [0014] FIG. 9 is a cross sectional view taken along the 9-9 line depicted in FIG. 6;
- [0015] FIG. 10 is an enlarged view of the circled area depicted in FIG. 8.

#### **DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS**

[0016] The present invention relates to a prescription adapter ring for use in eyewear, and in particular, a prescription adapter ring for use in wrap-type eyewear. In general terms, the adapter ring is designed and constructed so as to mount or otherwise be affixed to the frame of wrap-type eyewear and is also designed and constructed so as to maintain a prescription lens therein.

[0017] In one aspect of the present invention, the adapter ring is designed so that the rear surface or edge fits into a channel where a typical lens would be installed. Such a construction allows the adapter ring of the present invention to be used to retrofit existing eyewear. The front inner surface of the ring has a groove or channel to accept a prescription lens therein. Of course other methods of mounting the ring to the eyewear and for mounting a prescription lens therein are also envisioned. For example, although Figures 5 and 10 depict a square-shaped groove for maintaining the adapter ring, other shaped and sized mounting means are contemplated without departing from the spirit of the invention. The particular shape and size of the means for mounting the ring is a matter of application specific design choice.

[0018] In any event, as seen in the Figures, the rear portion of the adapter ring generally matches the wrap of the eyewear frame, while the front portion of the ring where the prescription lens is installed has less of a wrap. Thus, a higher power prescription lens can be mounted or otherwise installed in the adapter ring, thereby providing wrap-type

prescription eyewear, even for high power prescriptions. Thus, the prescription adapter ring permits Panoptix, Inc. to offer a high wrap prescription sunglass product.

[0019] The adapter ring of the present invention can be either fixed or removable from the eyewear. Further, the lens within the adapter ring can be either fixed or removable. Designed as such, a user will be able to readily switch lenses which will greatly increase the range and functionality of the eyewear. The adaptability of the present invention is further enhanced by incorporating an eyecup to the eyewear, which itself can be either fixed or removable and which may also incorporate a removable lens therein.

[0020] The sunglass frame can be any standard wrap-type frame with the typical lens removed. With regard to the eyecup, it can be removable or fixed, and may also have an additional lens installed therein, as described more fully in co-pending Application Serial No. \_\_\_\_\_, which is hereby incorporated by reference.

[0021] In a preferred embodiment, the eyewear of the present invention is also includes a ventilation means, such as for example, one or more ventilating apertures either incorporated as part of the ring itself or incorporated as part of the frame and/or eyecup.

[0022] In a preferred embodiment, the adapter ring is formed of an opaque, clear or translucent material. Formed as such, the adapter ring can serve as a side lens to provide enhanced peripheral vision and permit greater ambient light to reach the eyes of the wearer. Such a construction will aid in preventing and/or diminishing tunnel vision.

[0023] Thus, while there have been shown and described and pointed out novel features of the present invention as applied to preferred embodiments thereof, it will be understood that various omissions and substitutions and changes in the form and details of the disclosed invention may be made by those skilled in the art without departing from the spirit of the invention. It is the intention, therefore, to be limited only as indicated by the scope of the claims appended hereto.



[0024] It is also to be understood that the following claims are intended to cover all of the generic and specific features of the invention herein described and all statements of the scope of the invention which, as a matter of language, might be said to fall there between. In particular, this invention should not be construed as being limited to the dimensions, proportions or arrangements disclosed herein.

**CLAIMS**

What is claimed is:

1. A prescription adapter ring for use in wrap-type eyewear, said adapter ring being mountable to the frame of the eyewear and comprising a lens therein.

**ABSTRACT OF THE DISCLOSURE**

A prescription adapter ring for use in eyewear, and in particular, a prescription adapter ring for use in wrap-type eyewear.

**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION**

(Page 1 )

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**PRESCRIPTION ADAPTER RING AND EYEWEAR  
INCORPORATING THE SAME**

the specification of which

☒ is attached hereto

☐ was filed on  
International Application No.  
(if applicable).

as United States Patent Application No. or PCT  
and was amended on

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119(a)-(d) or §365(b), of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designates at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed:

<u>Country</u>	<u>Application No</u>	<u>Filed (Day/Mo./Yr.)</u>	<u>Priority Claimed</u> (Yes unless box is checked)
			<input type="checkbox"/>
			<input type="checkbox"/>
			<input type="checkbox"/>
			<input type="checkbox"/>
			<input type="checkbox"/>

**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION**

(Page 2 )

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below

Application No

Filed (Day/Mo./Yr.)

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

<u>Application No.</u>	<u>Filed (Day/Mo./Yr.)</u>	<u>Status (Patented, Pending, Abandoned)</u>
------------------------	----------------------------	--

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**POWER OF ATTORNEY:** As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith (list name and registration numbers).

Lawrence Rosenthal, Reg. No. 24,377  
Steven B. Pokotilow, Reg. No. 26,405  
James J. DeCarlo, Reg. No. 36,120  
Matthew W. Siegal, Reg. No. 32,941  
David L. Schaeffer, Reg. No. 32,716

COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION  
(Page 3 )

Send Correspondence to:

Steven B. Pokotilow, Esq.  
STROOCK & STROOCK & LAVAN LLP  
180 Maiden Lane  
New York, New York 10038

Direct Telephone Calls to: (name and telephone number)

Steven B. Pokotilow, Esq.  
(212) 806-5400

Full Name of Sole or First Inventor: Ernest R. Fernandez

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Citizen/Subject of: United States

Residence: 1379 Danby Avenue, San Jose, CA 95132

Post Office Address: 1379 Danby Avenue, San Jose, CA 95132

Full Name of Second Inventor, if any: Aaron M. Markovitz

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Citizen/Subject of: United States

Residence: 888 Logan Street, Apt. 11A, Denver, CO 80203

Post Office Address: 888 Logan Street, Apt. 11A, Denver, CO 80203

1/6

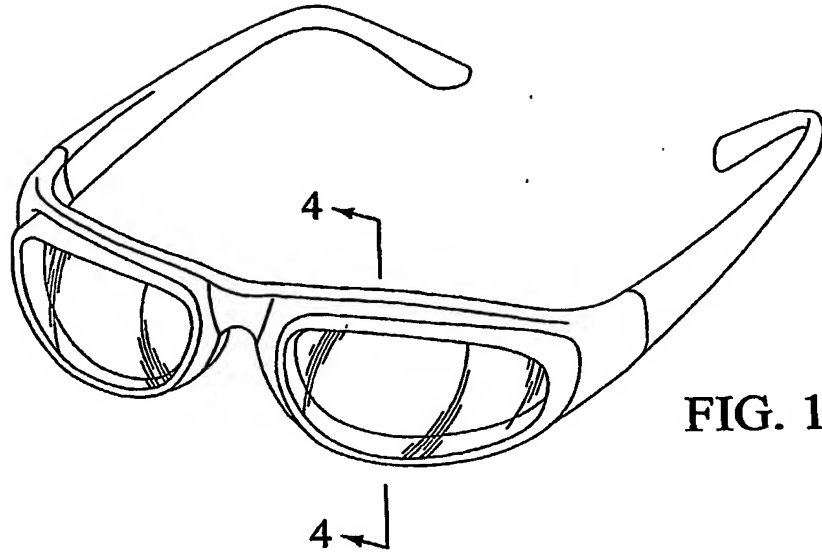


FIG. 1

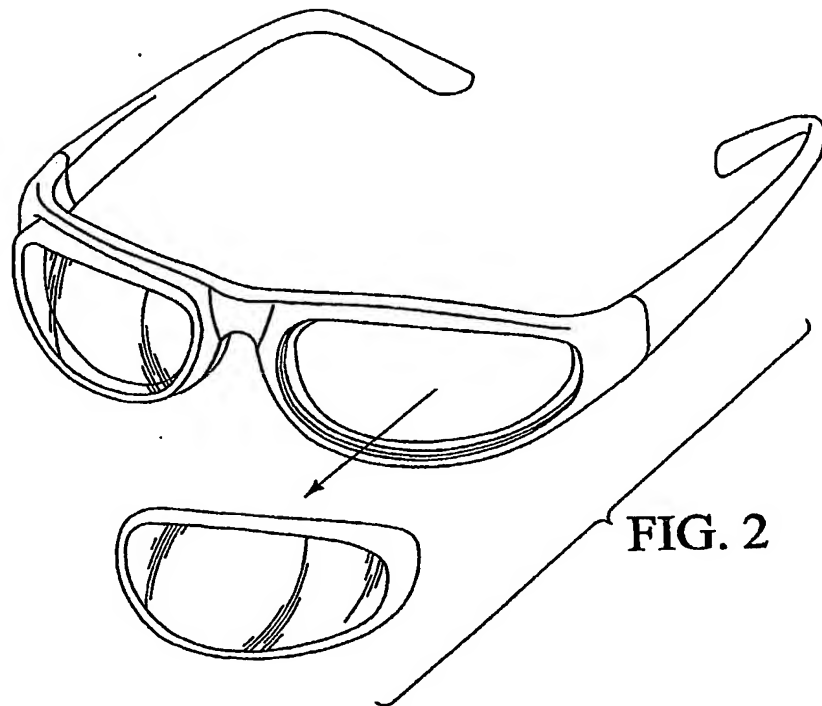


FIG. 2

2/6

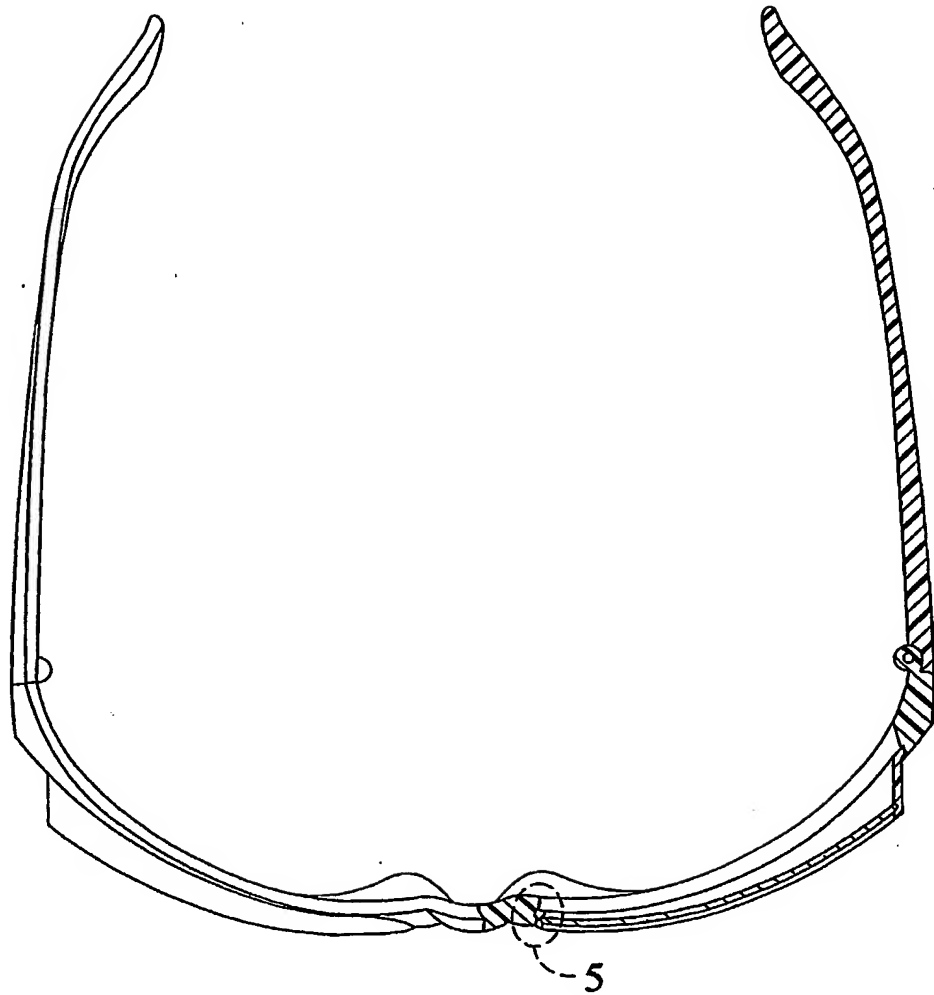


FIG. 3



3/6

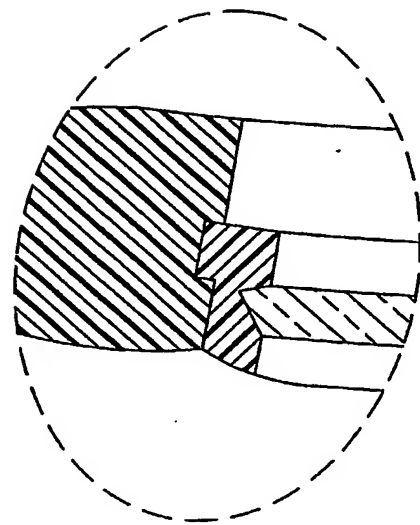
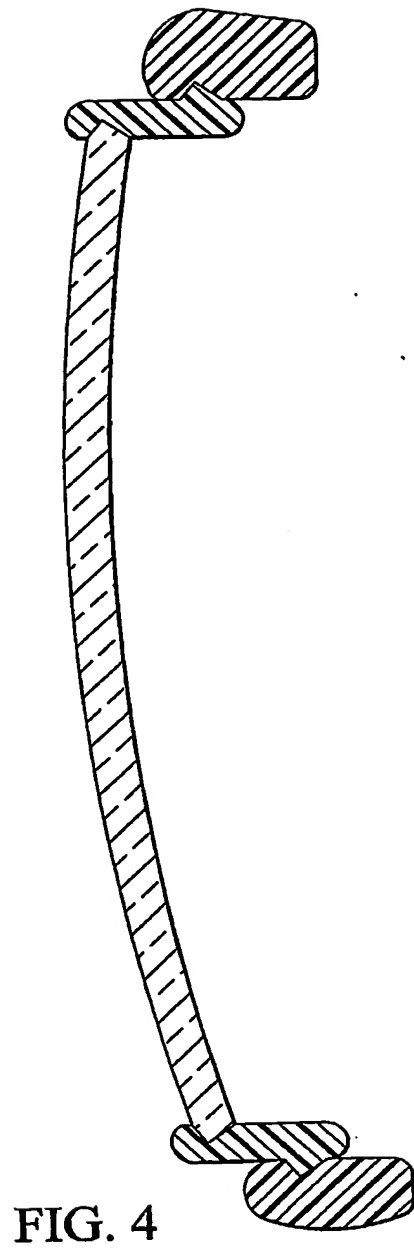


FIG. 5

4/6

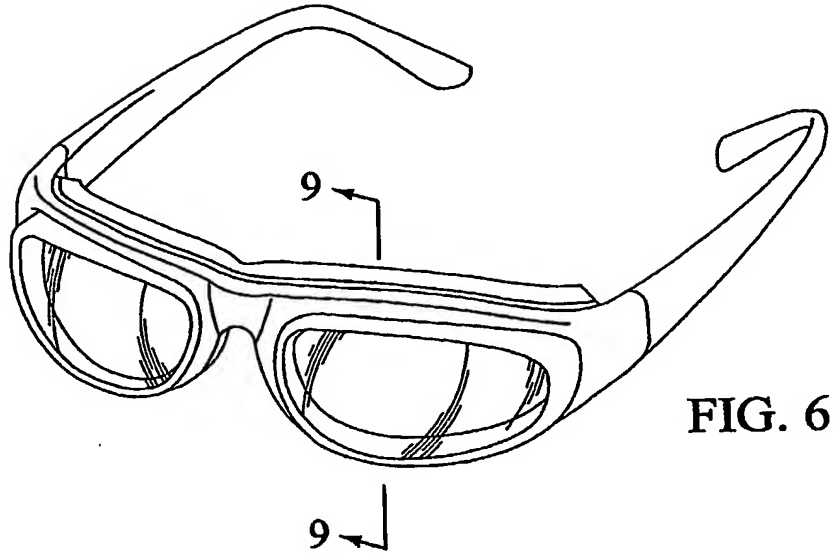


FIG. 6

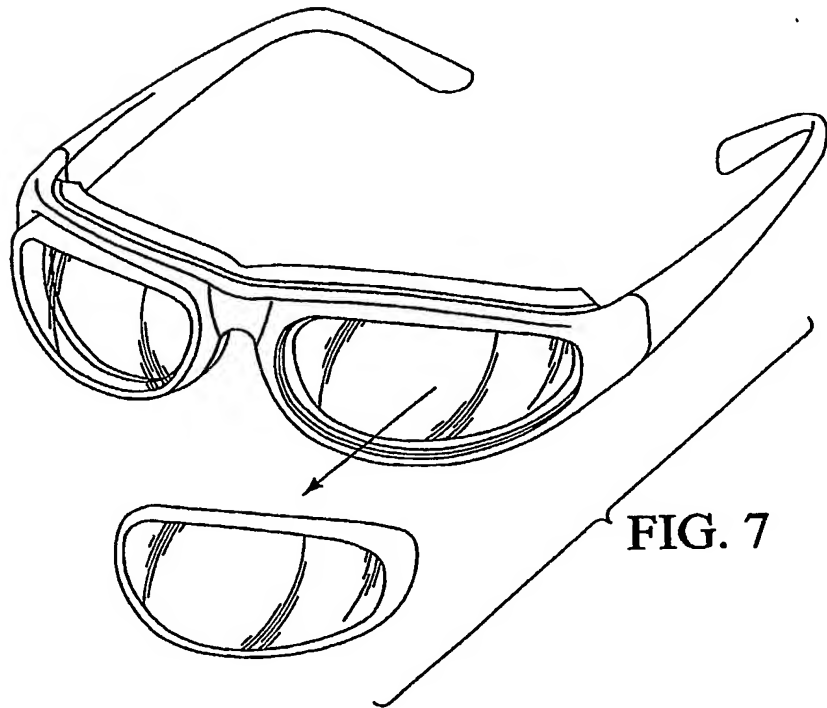


FIG. 7

5/6

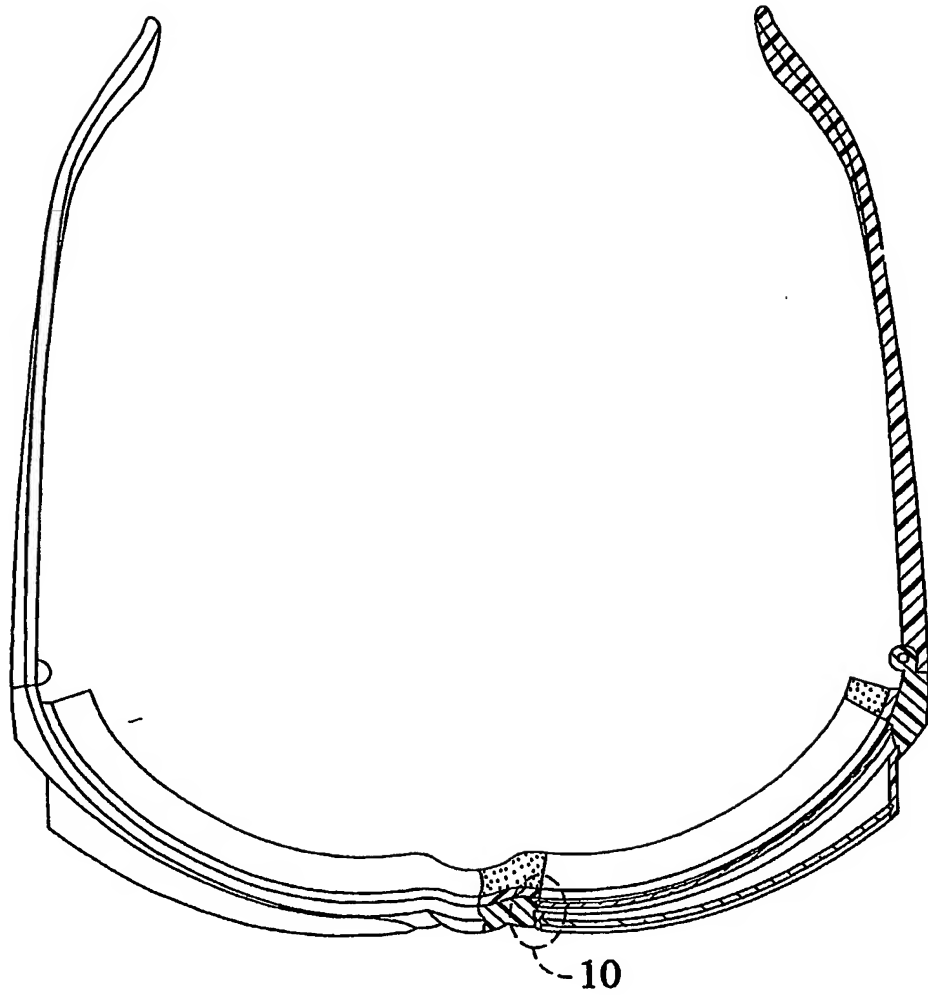


FIG. 8

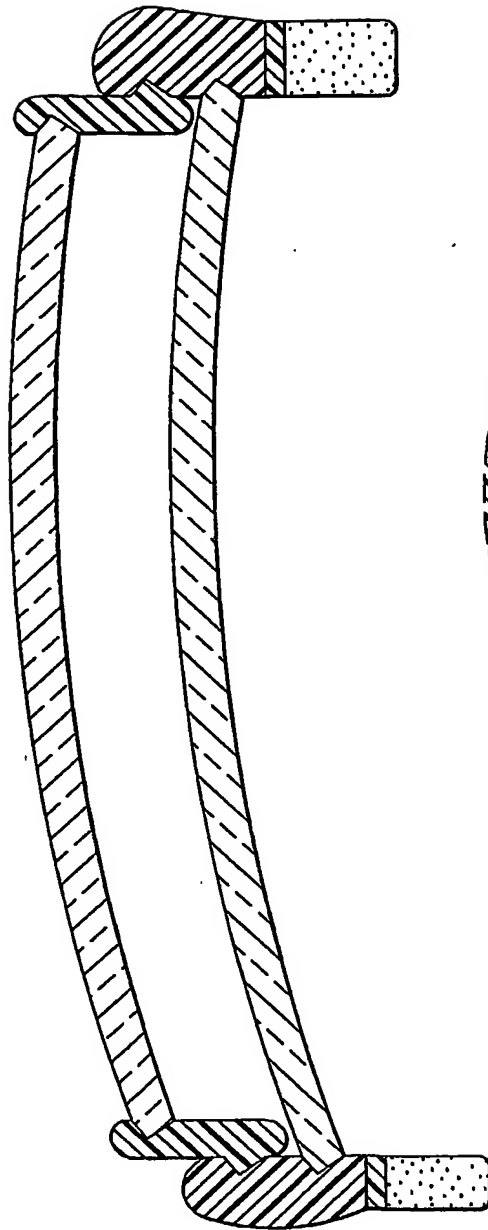


FIG. 9

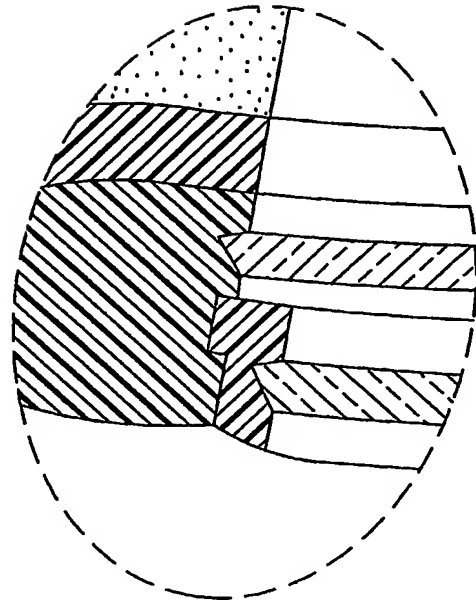


FIG. 10